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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,512	02/29/2008	Takehiro Matsumoto	47487-0003 (230337)	1013

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DRINKER BIDDLE & REATH (DC)
1500 K STREET, N.W.
SUITE 1100
WASHINGTON, DC 20005-1209

EXAMINER	
WILLIAMS, LELA	

ART UNIT	PAPER NUMBER
1789	

NOTIFICATION DATE	DELIVERY MODE
10/15/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DBRIPDocket@dbr.com
penelope.mongelluzzo@dbr.com

Office Action Summary	Application No.	Applicant(s)	
	10/590,512	MATSUMOTO ET AL.	
	Examiner	Art Unit	
	LELA S. WILLIAMS	1789	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 August 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's amendment filed on August 5, 2010 has been fully considered. The amendment is not persuasive and therefore, the following action is made final.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-6, 9-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suntory News Release No. 8691 in view of Herraiz et al., *"Analysis of wine distillates made from Muscat grapes (Pisco) by multidimensional gas chromatography and mass spectrometry."*

Regarding claims 1, 3-6, Suntory discloses a liquor product wherein maca and rose hip are infused in Andes white grape distilled spirits and finished with lime and lemon juice. The press release is silent to the use of Muscat grapes and the content of acetic acid with respect to the amount of pure alcohol therein. Muscat grapes are known to be used in the art, and as disclosed by Herraiz, Pisco, a beverage obtained by distillation of wine made from Muscat grapes, is one such product and is described as "being considered a high quality product" (page 1540). Therefore, it would have been obvious to one of ordinary skill to use said grapes in, the liquor of Suntory, in order to produce a beverage which would be regarded as "high quality". Herraiz also identifies in Table 1, that the Pisco intrinsically possesses an acetic acid in an amount of 100 mg/l (100ppm) of absolute ethanol.

Regarding claim 2, although the combination of Suntory in view of Herraiz discloses a maca extract alcoholic beverage, neither reference discloses the amount of maca contained in the

distilled liquor. However, since the instant specification is silent to unexpected results, the specific amount of maca contained in the distilled liquor is not considered to confer patentability to the claims. As the flavor is a variable that can be modified, among others, by adjusting the amount of maca contained in the distilled liquor, the precise amount would have been considered a result effective variable by one having ordinary skill in the art at the time the invention was made. As such, without showing unexpected results, the claimed amount cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine experimentation, the amount of maca contained in the distilled liquor in Suntory to obtain the desired flavor (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

Regarding claims 9-13 and 15, Suntory in view of Herraiz discloses a distilled liquor product made from Muscat grapes with an extract of maca, wherein the acetic acid content is 100 mg/l (100ppm) of absolute ethanol, contains lemon and lime juice, and rose hip extract. Therefore, given the combination of Suntory in view of Herraiz is identical to the presently claimed method, the combination of the references would naturally decrease the odor of maca extract contained in the beverage.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suntory News Release No. 8691 in view of Herraiz et al., "*Analysis of wine distillates made from Muscat*

***grapes (Pisco) by multidimensional gas chromatography and mass spectrometry.*" in further view of Ogawa et al. JP 2004-000171.**

Suntory and Herraiz are applied as discussed above for claim 1. Both references are silent to the extraction of maca. Ogawa teaches the addition of alcoholic extracted maca into food products (abstract). The maca was extracted with ethanol at room temperature (25^0C) or at 40^0C to raise the extraction efficiency [0020]. Given Ogawa's teaching of the alcohol extracted maca being a functional food which increases blood levels of growth hormones and stamina and the ability of the plant to prevent the decrease in physical strength, and the teaching that it can be provided in liquids and solutions [0021, 0060], one of ordinary skill in the art would have been motivated to extract the maca using ethanol as taught by Ogawa and incorporate it into the beverage of Suntory.

5. **Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suntory News Release No. 8691 in view of Herraiz et al., "*Analysis of wine distillates made from Muscat grapes (Pisco) by multidimensional gas chromatography and mass spectrometry.*" in further view of Gonzales et al. US. Pub 2006/0147600.**

Regarding claim 8, Suntory and Herraiz are applied as discussed above for claim 1. Both references are silent to the beverage being carbonated. Gonzales teaches a carbonated beverage product [abstract] containing maca. It would have been within the ambit of one of ordinary skill to carbonate the beverage of Suntory in order to produce a beverage which has a "fizzy" effect and would add a pleasant mouth feel to the beverage.

Regarding claim 14, Suntory and Herraiz are applied as discussed above for claim 9. Both references are silent to the beverage being carbonated. Gonzales discloses the use of carbon dioxide [0045] in the maca beverage for stabilization. Therefore, it would have been obvious to one of ordinary skill in the art to use carbon dioxide in Suntory for stabilization which would necessarily produce carbonic acid since it will intrinsically form.

Response to Amendment

6. Claims 1-15 are currently pending.

7. Applicant's amendments are sufficient to overcome the 35 U.S.C 112, second paragraph rejections set forth in the previous office action. Therefore, the rejection has been withdrawn.

Response to Arguments

8. Applicant's arguments filed August 5, 2010 have been fully considered but they are not persuasive. Applicant states:

> The Office's rejection is unsupported, because the combined references fail to provide evidence to support the Office's allegation that the combination would have been expected *and* predictable. Suntory8691 does not mention the odor of maca extracts, let alone suggest a means of masking or minimizing the odor. (Page 8)

However, claims 1-8 are directed to a maca extract beverage, which Suntory discloses, and the present claims fail to mention anything concerning odor. As stated, Muscat grapes are not disclosed; however, as stated by the Herraiz reference, Muscat grapes are known wine grapes and produce a "high quality" beverage. Applicant emphasized the reference disclosure of Pisco's quality varying; however, it is known that quality of wines vary throughout the art, many

manufactures produce both high and lower quality products and the manufacture of a lower quality product does not decrease the quality of "high quality" product. Furthermore, the international market or lack thereof would not affect the quality of said beverage, given that the beverage is still considered "quality" in its home market.

Regarding the masking or minimizing of odor, as previously stated, Suntory discloses a product wherein maca and rosehips are infused in Andes white distilled spirits and finished with lime and lemon juice, and it is noted that there is no mention of Muscat grapes; however, as shown by Herraiz, these grapes are known to be used in the art. This is further evidenced by The Uncorked Cellar webpage and wine*access* webpage. The web pages discloses "[t]he Muscat grapes is the world's oldest known grape variety." and "[Muscat grapes are] one of the more versatile white wine grapes...grown around the world for use in light and dry wines" respectively. It is for this clear and apparent reason that one of ordinary skill in the art to decide to use Muscat grapes. Although the combination of Suntory in view of Herraiz does not explicitly disclose the masking or minimizing of odor, "obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation", *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1966). Suntory in view of Herraiz contains identical components as the presently claimed method and the combination of the references would naturally decrease the odor of maca extract contained in the beverage.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The rejection is not based on hindsight but rather proper motivation to combine, i.e., the use of Muscat grapes to produce quality wine, found in the reference (Herraiz) itself.

Regarding Applicant's remarks to Ogawa and Gonzales, note that while the references do not disclose all the features of the present claimed invention, they are used as teaching references, and therefore, it is not necessary for these secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather these references teach a certain concept, namely the addition of alcoholic extracted maca into food products, extracted with ethanol at room temperature (25^0C) or at 40^0C to raise the extraction efficiency (Ogawaet al.) and the use of carbon dioxide [0045] in the maca beverage for stabilization (Gonzales et al.), and in combination with the primary reference, discloses the presently claimed invention.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LELA S. WILLIAMS whose telephone number is (571)270-1126. The examiner can normally be reached on Monday to Thursday from 7:30am-5pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LELA S. WILLIAMS
Examiner, Art Unit 1789

/L. S. W. /

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787